

REMARKS

Applicants note that the present application entered the U.S. national phase prosecution via the PCT. No lack of unity was found during the PCT prosecution. Applicants thus traverse the restriction requirement because it runs contrary to the findings of the PCT Examiner.

Applicants further traverse the restriction requirement because the combination of the Ding patent and the Eder et al. published application (cited in the paragraph spanning pages 2 and 3) of the restriction requirement, is irrelevant to the present claims. Claim 1 is not drawn to a two-part combination of a first *co*-polymer of vinyl acetate, vinyl acetal and vinyl alcohol, and a second *homo*-polymer of poly(vinyl pyrrolidone). (This is the Office's explicit characterization of what this combination of references teaches.) But that is not what is explicitly recited in present Claim 1, which requires a combination of a ternary *co*-polymer and a binary *co*-polymer. Thus, Applicants further traverse the restriction requirement because the Office's citation of the prior art in support of its allegation of lack of a single general inventive concept is without merit.

Applicants further traverse the restriction requirement because it is contrary to 37 CFR §1.475(b). The entire claim set recites a product (the coating and a device bearing the coating), and a process of using the product (applying the coating to a device). Thus, the claim set "will" have unity of invention as per §1.475(b).

Applicants therefore submit that the restriction requirement is improper. Withdrawal of the restriction requirement is respectfully requested.

An election of species requirement is proper only if the restricted species are independent or patentably distinct and there is no serious burden placed on the Office if an election is not required (MPEP §803). The burden is on the Office to provide reasons and/or examples to support any conclusion of patentable distinctness between the restricted species (MPEP §803). Applicants respectfully traverse the election of species requirement on the grounds that the Office has not carried the burden of providing any reason and/or example to support the conclusion that the restricted species are, in fact, distinct.

Also, as noted above, the burden is on the Office to provide sound scientific reasons or examples to support a conclusion of patentable distinctness. In the present instance, the Office

states that the species are deemed to lack unity of invention because they are not so linked as to form a single general inventive concept under PCT Rule 13.1. However, as above, Applicants submit that the Office has failed to properly make a case for a lack of unity of invention for the following reasons: (1) a finding of lack of unity runs contrary to the findings of the PCT Examiner; (2) the combination of Ding and Eder et al. fail to show that the common technical feature of the species is not novel; and (3) the claim set has unity of invention as per §1.475(b).

With regard to election of species requirements involving Markush-type claims, the Examiner's attention is also directed to MPEP §803.02:

If the members of the Markush groups are sufficiently few in number or so closely related that a search and examination of the entire claim can be made without serious burden, the examiner must examine all claims on the merits, even though they are directed to independent and distinct inventions. In such a case the, examiner will not follow the procedure described below and will not require restriction.

In the present case, Applicants respectfully note that the Markush recitations of Claim 1 recite only two members: Formula 1 is a random, ternary *co*-polymer containing a vinyl acetal, vinyl alcohol, and acetate monomers; Formula 2 is a binary *co*-polymer containing vinyl pyrrolidone and vinyl acetate monomers. Two members is an exceedingly small and well-contained group. Yes, there is variety within these two types of *co*-polymers, but at its core, there are only two different ingredients recited in claim 1: a ternary *co*-polymer of specified composition and a binary *co*-polymer of specified composition. Therefore, Applicants respectfully submit that MPEP §803.02, quoted above, controls and the election of species requirement is improper.

Lastly, Applicants note that with the provisional election of a single species, should no prior art be found that anticipates or renders obvious the elected species, the search of the Markush-type claims will be extended (MPEP §803.02).

Accordingly, because the Office has not carried the burden of providing technologically sound reasons or examples for concluding that the restricted species are patentably distinct, the election of species requirement is improper and should be withdrawn.



Applicants submit that the application is now in condition for allowance. Early notification of such action is earnestly solicited.

Respectfully submitted,

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